

Request for Reconsideration
Dated December 13, 2005

Appl. No. 09/748,616

REMARKS

Claims 1-48 are pending, claims 1-30, 43, 45, 46, and 48 were previously withdrawn from consideration.

CLAIM REJECTIONS

In the September 14, 2005 Office Action, claim 47 was rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Bush Jr. Claims 31-42 and 44 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Wheless in view of Bush Jr. Applicants respectfully assert that the rejections are improper and all of the claims are allowable.

The Claims are Not Anticipated

Claim 47 stands rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Bush Jr. Applicants respectfully traverse this rejection as the applied reference does not teach each and every element of claim 47, specifically a pocket with channels.

Claim 47 recites "[a]n apparatus for cutting an elongate substrate" which comprises "a plurality of pockets". The pockets support the substrate along its length (page 5, line 27) and also support the divided substrate after the cutting procedure (page 16, lines 15-16). Pockets are illustrated in Fig. 3 and 4 of this application which show the nesting properties and three dimensional character of a pocket. For example, Fig. 3 shows a pocket extending along the length of the elongate substrate, parallel to the axis of the elongate substrate.

The recitation of a pocket in this application is consistent with the dictionary definition of a pocket. For example, *The American Heritage® Dictionary of the English Language, Fourth Edition*, defines a pocket as a "receptacle, cavity, or opening", or as the familiar "small baglike attachment forming part of a garment and used to carry small articles, as a flat pouch sewn inside a pair of pants or a piece of material sewn on its sides and bottom to the outside of a shirt." Applicants disclosure of a pocket with three dimensional character and an opening is consistent with the

**Request for Reconsideration
Dated December 13, 2005**

Appl. No. 09/748,616

standard dictionary definition, and as such would be understood by one skilled in the art to which this invention pertains.

In contrast, Bush, Jr. et al teach a log processing machine with arms. Arms, as defined in *The American Heritage® Dictionary of the English Language, Fourth Edition*, are a "relatively narrow extension jutting out from a large mass." Indeed, the Bush arms illustrated in Fig. 1 are consistent with the dictionary definition. Applicants respectfully assert that the Bush, Jr. arms do not teach or suggest the pocket of this application.

Even if the disclosure of the Bush, Jr. was incorrectly assumed to disclose a pocket, Bush, Jr. does not teach or suggest a pocket having channels in accordance with claim 47.

An illustrative example of a pocket with channels is shown in Fig. 14 of this application. In Fig. 14 example, the left and right pocket assemblies contains two pockets aligned in series along the axis of the rotating shaft 82. Each pocket contains a plurality of channels. The uppermost pocket contains 16 channels. The lower pockets are shorter in length and contain 7 channels. The channels are part of the pocket.

In contrast, Bush Jr. et al. teaches a log processing machine with arms and spaces between the arms which the Office action contends to be a channel. By the Examiner's own admission, the channel of Bush, Jr. is between two arms. If two arms are required to define the channel, then clearly, the channel of Bush, Jr. is not part of the arm. "The elements must be arranged as required by the claim..." *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). It is error to treat the claims as a mere catalog of separate parts, disregarding the part-to-part relationship set forth in the claims. *In re Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). Applicants respectfully assert that Bush, Jr. does not teach or suggest a pocket having channels.

For the reasons presented herein, Bush, Jr. does not teach each and every element of claim 47, specifically a pocket, nor a pocket with channels, and

**Request for Reconsideration
Dated December 13, 2005**

Appl. No. 09/748,616

respectfully request that the rejection under 35 U.S.C. § 102 (b) over Bush, Jr. be withdrawn.

The Claims are Not Obvious

Claims 31-42 and 44 stand rejected 35 U.S.C. § 103(a) as allegedly being obvious over Wheless in view of Bush Jr. Applicants respectfully traverse this rejection as Wheless and Bush, Jr. (1) are not analogous art, and (2) nor do they teach each and every element, specifically a pocket as recited in independent claims 31 and 44.

First, Applicants respectfully assert that each of Bush, Jr. and Wheless is not analogous art and therefore cannot be relied upon under 35 U.S.C. § 103(a). MPEP 2141(a) states that:

"[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986);

As such, the determination whether a reference is analogous is a two part test: (1) whether the art is in the same field of endeavor; and (2) if not in the same field, is the art pertinent to the particular problems with which the inventor is involved.

Claims 31-42 and 44 of this application are directed at methods of cutting a flexible log. In contrast, Bush, Jr. and Wheless are directed at an apparatus for cutting nonflexible substrates: tree logs. Applicants respectfully assert that criteria 1 of the test for analogous art has not been satisfied.

The next step is consideration of criteria 2 of the test for analogous art: whether the reference is pertinent to the particular problems with which Applicants were concerned. As disclosed throughout the specification of this application, processing of flexible logs poses particular problems which the applicants were concerned including distortion of the finished product, especially in terms of shape

**Request for Reconsideration
Dated December 13, 2005**

Appl. No. 09/748,616

and cut squareness, prevention of undesired unwinding of the roll, and maintenance of a sanitary environment.

Applicants' concern with the problem of finished product distortion including shape and cut squareness is demonstrated at least by the discussion of counterbalancing the forces exerted on the log during the cutting procedure (page 15, line 3 to page 16, line 17) and Figures 11 and the disclosure of the shape of the pocket (page 10, line 18 to page 11, line 16 and Figure 4) designed to counterbalance these forces. A flexible log is readily deformable and has low rigidity. As such, maintaining the integrity of the log or roll before, during and after cutting is a problem which applicants were concerned with solving.

Bush, Jr. and Wheless each teach an apparatus for the cutting of rigid substrates which require minimal support during the cutting process, as exemplified by the lack of support required between the arm members of Bush, Jr. and Wheless to support the tree trunk. A substrate with longitudinal rigidity does not readily lose its shape as compared to a flexible log. Flexible logs require support on both sides of the cut to maintain cut squareness.

For the reasons presented herein, neither Bush, Jr. nor Wheless is either in the field of Applicants' endeavor, nor pertinent to the problems which Applicants sought to solve, and therefore are not proper references. Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Second, even if Bush, Jr. and Wheless was incorrectly assumed to be analogous art, the references either alone or in combination fail to teach each and every element, specifically a pocket as recited in independent claims 31 and 44.

Both independent claims 31 and 44 recite a pocket. Both Bush, Jr. and Wheless disclose arms for supporting a log at intermittent positions. As discussed previously in this Request, the Bush, Jr. arms do not teach or suggest a pocket. For similar reasons to that presented against Bush, the arms of Wheless, do not teach or suggest a pocket.

**Request for Reconsideration
Dated December 13, 2005**

Appl. No. 09/748,616

Even if the disclosures of the Wheless and Bush, Jr. were incorrectly assumed to disclose pockets, independent claim 31 recites that the pockets have channels and independent claim 44 recites that the pocket has a base defining a horizontal axis, first and second planar surfaces at an angle of 60-degrees above the horizontal axis.

With regard to independent claim 31, the fact that Bush, Jr. does not teach or suggest a pocket having channels has been discussed above in this Request. For similar reasons to that presented against Bush, Jr., Wheless does not teach or suggest a pocket having channels.

With regard to independent claim 44, the pocket has a base defining a horizontal axis, first and second planar surfaces at an angle of 60-degrees above the horizontal axis. An illustrative example of a pocket is shown in Fig. 4, where the base 79 defines horizontal axis 140, and planar surfaces 76 and 78 are aligned parallel and 60 degrees above the horizontal axis. In other words, a 60 degree angle is formed by the intersection of the lines defining the base and each of the planar surfaces.

In contrast, even if the Wheless recess was incorrectly assumed to be a pocket, the recess does not have a base defining a horizontal axis. Without teaching a base defining a horizontal base, Wheless cannot teach or suggest a first and second planar surfaces at 60 degree angles above the horizontal axis because, at the very least, there is no reference point with which to measure the 60 degree angle. Bush Jr. et al. does not teach or suggest a base defining a horizontal axis or a first and second planar surface wherein the planar surfaces are at an angle of 60-degrees above the horizontal axis, nor does the Office action contend that Bush Jr. teaches this.

For the reasons presented herein, either alone or combination, Wheless and Bush, Jr. et al. do not teach or suggest each and every element of independent claims 31 and 44, nor are Wheless and Bush, Jr. analogous art. As such a *prima facie* case of obviousness has not yet been presented, and Applicants respectfully request that the Examiner withdraw this rejection.


Request for Reconsideration
Dated December 13, 2005

Appl. No. 09/748,616

CONCLUSION

Applicants believe that currently pending Claims 31-42, 44 and 47 are patentable. Applicants respectfully request that the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned agent for the applicants via telephone if such communication would expedite this application.

Respectfully submitted,



Lisa M. Seaney, Ph.D.
Registration No. 56,246
Agent for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200